THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAMLESH GAGLANI

Appeal No. 1996-2239
Application No. 08/037,485[1]

HEARD: November 18, 1999

Before JOHN D. SMITH, WALTZ, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 15 and 17 through

[1] Application for patent filed March 24, 1993. According to appellant, this application is a continuation of Application No. 07/821,240, filed January 10, 1992, now abandoned; which is a continuation of Application No. 07/418,294, filed October 6, 1989, now abandoned.

28 which are all the claims remaining in the application.

Claim 16 was canceled by amendment executed November 15, 1993.

THE INVENTION

The invention is directed to an article having a metal surface with a coating thereon. The coating composition comprises 0.5 to 7.5% by weight of an amino carboxylate of a particular formula as a corrosion inhibitor. The coating composition also contains a pigment, a binder and a solvent.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced in the attached appendix.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

Andersen	2,926,108	Feb. 23, 1960
Stephen et al. (Stephen)	4,077,941	Mar. 7, 1978

THE REJECTION

Claims 1 through 15 and 17 through 28 stand rejected under 35 U.S.C. § 103 as unpatentable over Stephen in view of Andersen.

OPINION

We have carefully considered all of the argument advanced by appellant and the examiner. We agree with the examiner that the rejection of claims 1 through 5, 15, and 17 through 19 is well founded. Accordingly, we will sustain that rejection. We agree with the appellant that the aforementioned rejection over Stephen in view of Andersen of claims 6 through 14, and 20 through 28 is not well founded. Accordingly, we will not sustain that rejection.

The Rejection of Claims 1 through 5, 15, and 17 through 19

As an initial matter, appellants' Brief contains a statement that claims 5 and 19, Group II, and claims 6 through 14 and 20 through 28, Group III, do not stand or fall together with claims 1 through 4, 15, and 17, and 18, Group I. Accordingly, we will consider each set of claims separately.

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, and the claim language is to be read in view of the specification as it would be interpreted by one of ordinary

skill in the art. In re Morris, 127 F.3d 1048, 1053-1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976).

Our construction of the subject matter defined by appellants' claim 1 is that the claimed subject matter requires a metal surface having a coating composition thereon comprising an amino carboxylate salt, a pigment, a binder and a solvent coated thereupon. Stephen discloses a composition comprising the amino carboxylate salt of the claimed subject matter. See column 1, lines 44 through 68. The amino carboxylate salt is employed in an amount of 0.01% to about 5% by weight of the stabilized composition. See column 3, lines 44 - 46. The composition may be dissolved in suitable solvents as taught in column 3, lines 59 - 61, and contain pigments, column 4, lines 12 - 13. We find that the composition is specifically designed to be blended with cutting fluids. We refer to column 3, lines 25 - 32, wherein Stephen discloses that other materials can be stabilized by the disclosed compounds including "cutting fluids."

A "cutting fluid" is defined as a "fluid used esp. for cooling lubrication, rust prevention, or chip finishing in a machine metal cutting operation or for other special effects in other metal working operations."[2] Based upon the above analysis, we conclude that the cutting fluid is a binder for the amino carboxylate salts and coats the metal on which it is placed. Our position is fully supported by appellant's specification, at pages 4 and 5, wherein appellants prepare metal cutting fluids containing the amino carboxylate salt of the claimed subject matter, solvents and other additives. We conclude that "other additives" include pigments. Accordingly, the cutting fluids of the specification act as binders in the same manner as those taught by Stephen. Moreover as lubricants and rust preventatives they coat the metals upon which they are placed.

The examiner's position is further supported by Andersen who teaches corrosion inhibition of metallic substances by coating metals with a protective coating, See column 1, lines 28 - 30. Accordingly, we conclude that the examiner has

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[2]Webster's Third New International Dictionary, G & C Merriam Co. Springfield, MA, page 362, 1971.

established a *prima facie* case of obviousness over the claimed subject matter.

As to appellants' argument that there is no disclosure that the amino carboxylates are corrosion inhibitors, it is our conclusion that although the claimed subject matter requires their presence, it is silent as to their function. Therefore, the teaching of their presence by the references of record is sufficient to meet the requirements of the claimed subject matter.

With respect to claims 5 and 19, we find that Stephen discloses amino carboxylates wherein R_1 and R_2 are alkyl having 1 to 18 carbon atoms. See column 2, lines 3-4. We conclude that it would have been obvious to one of ordinary skill in the art to have chosen particular alkyl groups from among those disclosed by Stephen.

The Rejection of claims 6 through 14 and 20 through 28

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner

relies upon Stephen for a disclosure of amino-carboxylate salts as light stabilizers for coating various substrates. It is the examiner's position that the coating compositions comprise resinous materials. See Answer, page 4. Andersen is relied upon as teaching amino-carboxylates as coating materials for preventing corrosion by covering the surface of a metallic surface with a protective coating. See Answer, pages 5 and 6. Accordingly, "the ordinary practitioner would have found it obvious to formulate a metal article having a coating thereon which comprises an amino-carboxylate salt, a pigment a binder and a solvent." See Answer, page 7. As to this set of claims we disagree with the examiner's analysis and conclusions.

The organic materials required by the claimed subject matter are polymeric materials. Stephen teaches polymeric materials at column 2, line 62- column 3, line 24. When the amino-carboxylates are added to a polymeric substrate, they may be blended before or after polymerization or sprayed on the surface of polymeric films, fabrics, or filaments. See column 3, lines 50 - 64. However, there is no disclosure, suggestion or teaching of utilizing the amino-carboxylates together with the polymeric materials of Stephen as a coating composition.

Either the amino-carboxylates are mixed with polymeric material or sprayed thereon.

Similarly, Andersen contains no suggestion of including a polymeric binder. Accordingly, the references neither disclose, nor teach a coating composition containing a polymeric binder as required by the claimed subject matter.

Therefore, we are constrained to agree with appellants that the examiner has failed to establish a prima facie case of obviousness. The examiner has not provided any evidence or scientific explanation on this record why one of ordinary skill in the art would have found in the disclosure of the combined teachings of Stephen and Andersen a suggestion to prepare a coating composition using amino-carboxylates and polymeric binder. The examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. We determine that there is no reason, suggestion, or motivation to combine the references in the manner proposed by the examiner. Accordingly, the examiner has not established a prima facie case of obviousness. See In re

Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

DECISION

The rejection of claims 6 through 14 and 20 through 28 under 35 U.S.C. § 103 as unpatentable over Stephen in view of Andersen is reversed.

The rejection of claims 1 through 5, 15, and 17 through 19 under 35 U.S.C. § 103 as unpatentable over Stephen in view of Andersen is affirmed.

The decision of the examiner is affirmed-in-part.

AFFIRMED-IN-PART

JOHN D. SMITH Administrative Patent Judge	)
THOMAS A. WALTZ Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES

)
PAUL LIEBERMAN)
Administrative Patent Judge)

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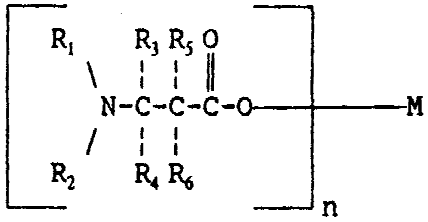
APPENDIX

1. An article having a metal surface and a coating composition thereupon, said coating composition comprising

(a) from about 0.5 to about 7.5 weight percent of a corrosion inhibitor comprising at least one aminocarboxylate salt of the formula:



wherein M is a metal ion of zinc, tin or calcium and n=2-4; R_1 and R_2, independent of each other, is H, C_1-C_{20} alkyl, aryl, or alkylene and where R_1 and R_2 may also combine to form a fused cycloalkyl group or a cycloalkenyl group; R_3, R_4, R_5 and R_6, independently of each other, are hydrogen, lower alkyl or substituted lower alkyl, phenyl, cycloalkyl having 5 to 6 carbon atoms, or benzyl;

(b) a pigment;

(c) a binder; and

(d) a solvent